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IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 73-187

KEWANEE OIL COMPANY,

v.

BICRON CORPORATION, ET AL.

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF AMICUS CURIAE OF THE ASSOCIATION FOR THE ADVANCEMENT OF INVENTION AND INNOVATION IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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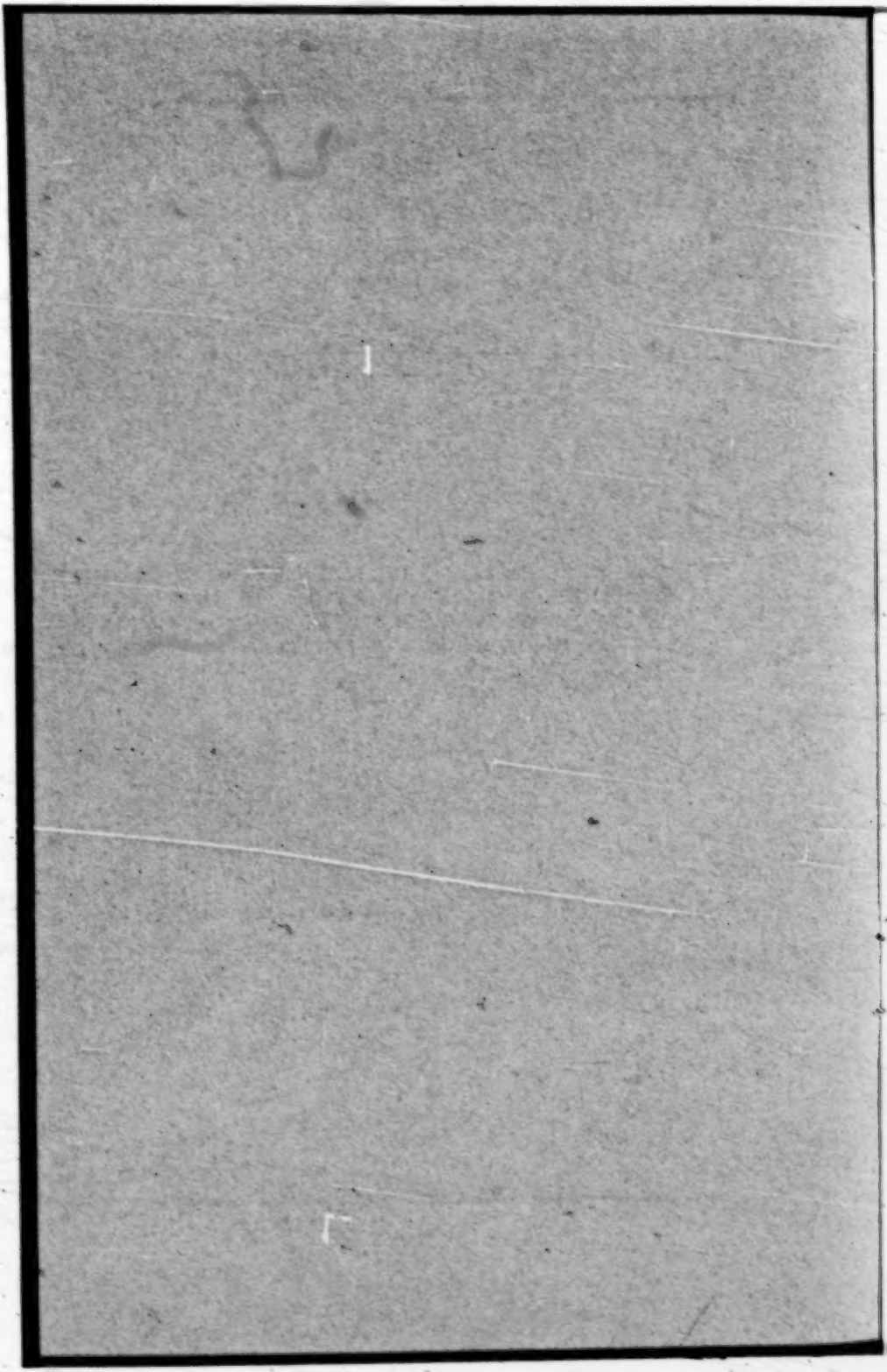

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MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

TO THE HONORABLE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

The Association for the Advancement of Invention and Innovation respectfully moves for leave to file the annexed brief amicus curiae in connection with the petition in the captioned case for writ of certiorari to the United States Court of Appeals for the Sixth Circuit.

Consent to the filing of said brief was originally planned to be sought from both parties through their attorneys of record. However, the Association has been advised that the counsel for BICRON CORPORATION, ET AL., defendant-respondents, are opposing

such requests so that this motion becomes necessary under Rule 42 of this Court.

This motion and the attached brief are submitted because the petition in this case raises issues of profound importance to the entire process of invention and innovation in our country and to the future well-being of all of its citizens. These are issues of public import that the parties cannot adequately address directly within the private scope of their pleaded controversy.

The Association has a deep concern for providing a favorable climate for invention and innovation in the country for the public good and believes that it is not an overstatement to say that the present case concerns fundamental issues which are perhaps of greater importance to the future of the invention and innovation in the country than any other case which this Court has considered in its history.

Respectfully submitted,

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BRIEF AMICUS CURIAE OF THE ASSOCIATION FOR THE ADVANCEMENT OF INVENTION & INNOVATION URGING THE GRANT OF A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

I. NATURE OF THE AMICUS

The Association for the Advancement of Invention & Innovation is a non-profit professional association of inventors, entrepreneurs, research directors, businessmen, scientists, engineers, lawyers, patent attorneys, educators, former government officials and others who are dedicated to the proposition of improving the climate for invention and innovation in our country. The combined background of the membership embraces the

entire spectrum of the process of invention (conceiving the idea) and innovation (bringing the invention to the marketplace).

II. INTEREST OF THIS AMICUS

The Association believes that to foster an appropriate climate for invention and innovation in our country there must be (1) uniformity and certainty in the law relating to the process of invention and innovation to enable proper planning and management of such process and (2) incentives to invest the time, money and effort to make inventions and innovations. The present case in the view of the Association raises basic issues having a major impact on the process of invention and innovation in the country both at the present time as well as the long-range future.

III. WHY THE PETITION FOR WRIT OF CERTIORARI SHOULD BE GRANTED

A. On the Question of Uniformity and Certainty

The decision below creates a situation in the country of non-uniformity and uncertainty with regard to the protection of trade secrets and confidential know-how which will have an adverse effect on the proper planning and management of the process of invention and innovation . Admittedly, the decision departs from the long-established law in this field elsewhere in the country. Thus, managers of invention and innovation are faced with a multitude of complex questions, such as:

(1) Should the payment of royalties under existing know-how license agreements be continued or discontinued?

(2) Should new license agreements be negotiated and if so, on what basis?

(3) Should budgets for research and development be reduced?

(4) What assurances, if any, can U.S. companies give foreign licensors of technology needed by the country with regard to maintaining know-how confidential?

(5) How can U.S. companies protect the confidentiality of their know-how licensed to foreign companies and the royalty payments payable thereunder?

(6) Should a program of copying know-how of other companies be substituted for a company's research and development program?

(7) Should research and development laboratories be moved from states in the Sixth Circuit to other states?

B. On the Question of Public Policy Affecting Incentives for Invention and Innovation

The decision below raises a number of major public policy questions which require the attention of this Court, namely:

(1) Are state laws protecting trade secrets in conflict with the United States patent laws:

(2) Should a voluntary agreement between an employer and an employee under which the employee is to make inventions and innovations for the employer and keep them confidential not be binding on both parties?

(3) Will the decision below in fact promote or debilitate the progress of the useful arts in our country?

(4) If the basic law is to be changed in this field in a way which will have a major impact on the economic system of the United States (e.g., balance of trade, productivity, etc.), should such change be effected by judicial action or by the Congress?

(5) Is the decision below consistent with the provisions of the international treaties signed by the United States in the field of trade secrets?

IV. CONCLUSION

For the foregoing reasons, the interests of the public in having uniformity and certainty in the law relating to trade secrets and appropriate incentives for invention and innovation should be promoted by granting the petition for a writ of certiorari.

Respectfully submitted,

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October Term, 1973

No. 73-187

KEWANEE OIL COMPANY,

Petitioner,

against

BICRON CORPORATION, *et al.*,

Respondent.

MOTION BY THE NEW YORK PATENT LAW ASSOCIATION FOR LEAVE TO FILE A BRIEF AS *AMICUS CURIAE* IN SUPPORT OF THE PETITION FOR A WRIT OF CERTIORARI

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MOTION BY THE NEW YORK PATENT LAW ASSOCIATION FOR LEAVE TO FILE A BRIEF AS *AMICUS CURIAE* IN SUPPORT OF THE PETITION FOR A WRIT OF CERTIORARI

The New York Patent Law Association hereby moves the Court for leave under Rule 42 (1) to file the accompanying brief, as an *amicus curiae,* in support of the petition of Kewanee Oil Company for the issuance of a writ of certiorari—to effect a review by this Court of the decision of the Court of Appeals for the Sixth Circuit in this case holding that the trade secret laws of Ohio are in conflict with, and hence pre-empted by, the Federal patent laws.

Consent to the filing of the accompanying brief was requested of the parties, and the petitioner consented, but the respondents declined, stating that "Respondents will not consent . . . [but] will not, however, oppose the motion of the Association." In view of this lack of unanimous consent, the Association is proceeding by way of this motion.

The interest of the Association, as discussed in greater detail in the accompanying brief, is predicated upon the interests of its 1,200 lawyer members, who have active practices in the field of intellectual property and, as such, have day-to-day contact with the patent and trade secret laws, the operation of these laws and their impact upon both individuals and corporations, and the effect these laws have upon industrial growth, economic development and general public welfare.

The concern of the Association with the decision of the Court of Appeals in this case is predicated not only upon its interest in the proper development of the patent and trade secret laws but also upon the serious and far reaching impact of this decision, both nationally and internationally, and the uncertainty it projects as a consequence of its acknowledged conflict with the decisions of the four other Courts of Appeals that have ruled upon the same issue. This conflict has been discussed in the accompanying brief, but the Court's attention is directed also to the apparent conflict even within the Court of Appeals for the Sixth Circuit itself. Thus, since its decision in this case, another panel of the same court has affirmed a criminal conviction, and consequent imprisonment, based upon the theft of a trade secret from a corporation located in New Jersey. See *United States* v. *Greenwald* in which a petition for a writ of certiorari has already been made to this Court, as Petition No. 73-24.

As a consequence of this Association's long commitment to the patent and trade secret fields, its strong interest in the proper development of the law in these fields, and its grave concern over the far reaching effects which an improper decision vitiating long-standing trade secrets rights will have, all of which are discussed in the accom-

panying brief, it is respectfully urged that leave to file this brief be granted.

Respectfully submitted,

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Certificate of Service

The undersigned hereby certifies that copies of the foregoing Motion and the accompanying Brief were on this ..... day of ....., 1973 mailed by regular local mail or airmail to counsel for Petitioner and Respondent, i.e. airmail to Mr. Edward P. Troxell, Jones, Day, Cockley and Reavis, 1750 Union Commerce Building, Cleveland, Ohio 44115, local mail to Mr. Roger Milgrim, Milgrim, Tomajan and Jacobs, 25 Broadway, New York, New York 10004 and airmail to Mr. William C. McCoy Jr., Bosworth, Sessions & McCoy, 625 National City Bank Bldg., Cleveland, Ohio 44114.

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